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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/596,629

06/19/2000

Connic L. Chapman

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10/31/2006

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/596,629

Applicant(s)

CHAPMAN ET AL.

Examiner

Douglas B. Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 are currently pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 60-68 and 70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 60-68 and 70 are non-statutory because they are directed towards a computer-readable medium containing that is not tangibly embodied and does not create a tangible and concrete result.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,377,355 to Hager et al. in view of U.S. Patent Number 5,781,901 to Kuzma.

Art Unit: 2142

6. Hagar teaches the invention substantially as claimed (As in claim 52) including an intranet embodied on a computing device comprising a plurality of software modules for distributing an invention disclosure, the intranet having a plurality of users enrolled therein, each of the plurality of users having associated personnel information stored within the intranet (col. 5, lines 1-15), the intranet comprising: a software module for accessing an invention disclosure template form over the intranet; a software module for accessing an invention disclosure template form, the invention disclosure being created by an inventor and including information about an invention; a software module for selecting an option in the invention disclosure template form to include an attachment with the invention disclosure; a software module for submitting the invention disclosure over the intranet (col. 4, lines 40-61); a software module for creating a profile of the invention disclosure based upon a technical area relating to the invention disclosure in response to accessing associated personnel information of the inventor (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting first notification message via e-mail to a first group of users based upon the created profile, the first group of users being within the plurality of users (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting a second notification message via e-mail to a second group of users based upon the created profile, the second group of user being within the plurality of users and including a technical review coordinator (col. 6, lines 17-34); a software module for selecting at least one evaluator by the technical review coordinator (col. 9, lines 66-68 and col. 10, lines 1-9); a software module for transmitting a third notification message via e-mail to the at least one evaluator (col. 6, lines 17-34); a software module for submitting evaluation comments by the at least one evaluator (col. 7, lines 5-42); an software module for submitting a recommendation of

Art Unit: 2142

the invention disclosure by the technical review coordinator based upon the evaluation comments (col. 9, lines 37-57); and a software module for transmitting the recommendation of the invention disclosure via e-mail to the first and second group of users (col. 10, lines 29-58); however Hager does not teach including an attachment to the invention disclosure created separately from the invention disclosure nor e-mailing a hyperlink to the document.

Official notice is taken that it was well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure with the idea of sending a hyperlink instead of an entire document because sending only a hyperlink reduces the size of e-mails that would be sent, thus reducing network traffic.

Kuzma teaches a software module comprising instruction for including an attachment to a document the attachment having been created separate from the document (col. 4, line 65-col. 5, line 24).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure with the teachings of Kuzma regarding creating an attachment separately from a document because creating an attachment separately from a document saves network resources (Kuzma, col. 1, lines 35-50). However the Hager-Kuzma combination does not explicitly teach a software module for attaching a file to the invention disclosure without the use

Art Unit: 2142

of a hyperlink, the file being created by the inventor separate from the invention disclosure and including information about the invention that is not included in the invention disclosure.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine teachings of the Hagar-Kuzma combination regarding the separate creation of an attachment with the idea that the attachment is not attached with a hyperlink but rather is just attached because it is obvious to omit an element if the element's function is not required (See MPEP section 2144.04). In other words, it would have been obvious to just plain attach a Word or Powerpoint document as argued by the applicant rather than attach a hyperlink to such a document. Either way, the attachment requires some form of link, otherwise one would never know that it is there.

7. As to claims 53, Hager teaches an intranet wherein the software module for transmitting the first notification message is responsive to submission of the invention disclosure (col. 4, lines 62-67 and col. 5, lines 1-15).

8. As to claim 54, Hager teaches an intranet wherein the software module for transmitting the second notification message is responsive to submission of the invention disclosure (col. 6, lines 17-34).

9. As to claim 55, Hager teaches an intranet wherein the profile comprises a functional manager of the inventor, a patent attorney, and technical review person (col. 5, lines 33-41).

10. As to claim 56, Hager teaches a profile comprising information relating to the inventor including the inventor's employee number, department number, building number, phone number and e-mail address (col. 4, lines 62-67 and col. 5, lines 1-15).

Art Unit: 2142

11. As to claim 57, Hager teaches an intranet wherein the first group of user comprises a business area manager, a supervisor of the inventor, and the inventor (col. 4, lines 62-67 and col. 5, lines 1-15).

12. As to claim 58, Hager teaches an intranet wherein the second group of users comprises a technical review coordinator, a contract administrator if the invention was developed under government funds, and an intellectual property administrator (col. 7, lines 32-42).

13. As to claim 59, Hager teaches a software module for creating an invention disclosure further comprising instructions for including an attachment (col. 4, lines 40-61).

14. As to claim 60, Hager teaches a software module for creating an invention disclosure comprising instructions for sending a notification message to a co-inventor (col. 4, lines 40-61). For reasons discussed above it would have been obvious to include a hyperlink in this message.

15. As to claims 1-11, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

16. As to claims 12-21, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

17. As to claims 22-30, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

18. As to claims 31-41, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

19. As to claims 42-51, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

Art Unit: 2142

20. As to claims 61-70, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

### ***Response to Arguments***

21. Applicant's arguments filed 11/17/2005 have been fully considered but they are not persuasive. The applicant does not argue that Hagar fails to teach the applicant's claimed process or that an attachment was not well known at the time of the applicant's invention. The applicant is arguing that it would not have been obvious to use attachments with the Hagar invention. In response to the applicant's arguments, the Examiner points out the fact that even though Hagar does not explicitly describe attachments does not preclude the Hagar invention to be modified to include attachments. That is why the rejection is an obviousness rejection and not an anticipation rejection. The combination of known elements is not patentable if it would have been obvious to combine these elements even though there may not be any explicit example of the combination. In the present application, using attachments to convey information would have been obvious for the reasons pointed out above.

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone numbers for the



Art Unit: 2142

organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair

DBB



ANDREW CALDWELL  
SENIOR PATENT EXAMINER